

REMARKS

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.116, and in light of the remarks which follow.

Entry of this Amendment is proper under 37 C.F.R. § 1.116, because the Amendment places the application into condition for allowance (for the reasons discussed herein), or places the application into better form for an Appeal should an Appeal be necessary. The Amendment does not raise the issue of new matter, and does not raise new issues requiring additional search and/or consideration. The amendments and remarks were not presented earlier because they are in response to issues raised in the Final Rejection. Applicants respectfully request entry of the Amendment.

Applicants thank the Examiner for entry and consideration of Applicants' Amendment of June 21, 2007.

Claims 10-21 are pending in the application, Claim 22 having been canceled above without prejudice to or disclaimer of the subject matter therein.

By the above amendments, Applicants amended Claims 10 and 21 to address the § 112 issues and claim objection, and canceled Claim 22 without prejudice or disclaimer in view of the Official Action's Requirement for Election. A claim that has been amended in a manner that does not narrow the claim's scope should be accorded its full range of equivalents.

Turning now to the Official Action, Claim 22 is withdrawn from further consideration for being directed to non-elected subject matter pursuant to the Official Action's stated Requirement for Election. In an effort to expedite prosecution of the

application, Applicants have canceled Claim 22 without prejudice or disclaimer.

Applicants, of course, reserve the right to pursue protection for the subject matter defined in Claim 22 in a continuing application.

Claims 10-17 and 19-21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. For at least the reasons that follow, withdrawal of the rejection is in order.

First, with respect to the rejection of Claim 10 and its dependent claims for recitation of a broad range or limitation together with a narrow range or limitation, Applicants amended Claim 10 to obviate the rejection. In particular, Applicants deleted “advantageously between 5 and 25 and optionally between 9 and 20.”

With respect to the rejection of Claim 21, Applicants amended the claim by deleting “process” and adding --adhesive composition-- so that the claim reads, in part, “The adhesive composition as claimed in Claim 18...”

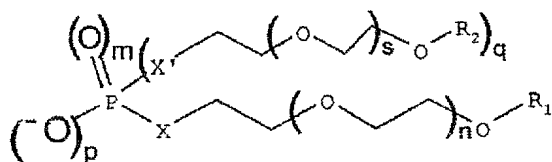
For at least these reasons, Applicants respectfully request reconsideration and withdrawal of § 112, second paragraph, rejection of Claims 10-17 and 19-21.

Claim 21 stands objected to under 37 C.F.R. § 1.75(c) as being in improper dependent form. Applicants respectfully submit that the foregoing amendment made to Claim 21 to address the § 112 issue should also obviate the objection to Claim 21 under § 1.75(c).

Applicants respectfully request reconsideration and withdrawal of the claim objection.

Claims 10-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nabavi (WO 97/31960 translated by U.S. Patent Application Publication No.

an isocyanate composition a) with a mass content of N=C=O function of between 10% and 30%, and with a viscosity of not more than 2500 mPa.s, and a surfactant b) comprising a compound or a mixture of compounds of mean general formula:



wherein:

p represents a value between 1 and 2 (closed intervals, i.e., comprising the limits);

m represents zero or 1;

the sum $p+m+q$ is equal to 3;

the sum $1+p+2m+q$ is equal to 3 or 5;

X is an oxygen;

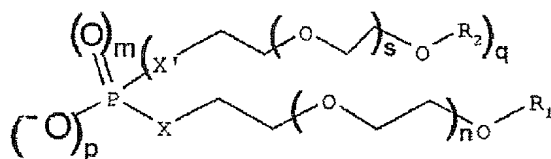
X' is an oxygen;

n and s have the same statistical value, chosen between 5 and 30 carbon atoms. (Emphasis added.)

Independent Claim 18 defines an adhesive composition, comprising:

an isocyanate composition a) with a mass content of N=C=O function of between 10% and 30% and with a viscosity of not more than 2500 mPa.s;

a surfactant b) comprising 50% by mass of a compound or mixture of compounds of general formula:



wherein:

p represents an integer between 1 and 2;

m represents 0 or 1;

the sum p+m+q is equal to 3;

the sum 1+p+2m+q is equal to 3 or 5;

X is an oxygen;

X' is an oxygen;

n and s, which are identical or different, represent an integer chosen between 5 and 30, wherein R₁ and R₂, which are identical, are chosen from aryl radicals,

R₁ and R₂ represent an alkylaryl of 10 to 20 carbon atoms; and

an aqueous phase with a pH of between 4 and 9. (Emphasis added.)

It is well-established that in order to demonstrate anticipation under § 102, each feature of the claim at issue must be found, either expressly described or under principles of inherency in a single prior art reference. (See, *Kalman v. Kimberly-Clark Corp.*, 218 U.S.P.Q. 798 (Fed. Cir. 1983).) That is not the case here.

Nabavi relates to isocyanate-based compounds and compositions. It also

relates to their process for utilization, their utilization for producing coatings and coatings thus obtained. (See, Nabavi at Col. 1, paragraph [0001].) In particular, Nabavi is directed to compositions for use in paints and varnishes. (See, Nabavi at Col. 1, paragraph [0005].)

Clearly, the pending independent claims are directed to a process for preparing adhesive compositions and an adhesive composition, which make use of emulsifiable isocyanates comprising isocyanate and surfactant. In stark contrast, Nabavi describes compositions based on isocyanate comprising compounds having anionic functions and a fragment of polyethylene glycol. In particular, the compositions of Nabavi are paints and/or varnish compositions. (See, Nabavi at Col. 1, paragraph [0005], [0010] and [0011].) (Also see, Nabavi at page 10, Examples 10-12, which discuss industrial paint compositions.) Nowhere does Nabavi disclose or suggest a process for preparing an adhesive composition or an adhesive composition, as claimed.

Furthermore, Applicants submit that one of ordinary skill in the art would not have been motivated by Nabavi to use isocyanate paint or varnish compositions as adhesive compositions especially since the properties of paint and varnish compositions (e.g., gloss, chemical resistance, and hardness (discussed at Examples 10-12 of Nabavi)) are totally different from the properties of adhesive compositions (e.g., breaking strength and peeling (discussed on pages 26 and 28 of the instant specification)).

Accordingly, Applicants submit that Nabavi does not anticipate the process for the preparation of an adhesive composition defined in independent Claim 10 or the adhesive composition defined in Claim 18 because Nabavi does not disclose or fairly

suggest a process for preparing an adhesive composition or an adhesive composition. Nabavi is instead directed to processes for preparing paint and varnish compositions and the resulting paint and varnish compositions.

Further, in evaluating the patentability of independent Claims 10 and 18, Applicants submit that consideration of the elements recited in the preamble of the independent claims is appropriate. Applicants submit that these elements cannot be ignored under applicable legal precedent. Specifically, Applicants submit that the elements recited in the preambles of the above-identified independent claims further distinguish the claimed process and composition from Nabavi. The elements recited in the preambles of these claims help to demonstrate that the claimed process and composition are substantially different from those disclosed or suggested in Nabavi (i.e., to produce paint and varnish compositions having properties such as gloss, chemical resistance and hardness as opposed to adhesive compositions that exhibit breaking strength and peeling).

It has been established that when the preamble gives life and meaning to the claimed subject matter, then its elements do limit the scope of the claim. (See, *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d at 866, 288 U.S.P.Q. at 92; *Perkin-Elmer Corp. v. The Computer Vision Corp.*, 732 F.2d 888, 896, 221 U.S.P.Q. 669, 675 (Fed. Cir. 1984)). Furthermore, courts have found claim preambles to be "limiting when the introductory phrase was deemed essential to point out the invention defined by the claim...." (See, *Kropa v. Robie*, 187, F.2d 888, 150 U.S.P.Q. 478, 481 (C.C.P.A. 1951).)

Because the phrases used in the preambles of the above independent claims clearly define the claimed process and composition as a process for the preparation

of an adhesive composition and an adhesive composition, Applicants submit that the preambles of the claims point out the invention defined therein and, thus, give life and meaning to the claimed subject matter.

Additionally, courts have held that the preamble of a claim is limiting when the claim expressly incorporates language of the preamble into the body of the claim. (See, for example, *CFMT, Inc. v. Yeldup International Court*, 92 F.Supp.2d 359 (D. Del. 2000).) For example, in the present application, independent Claim 10 defines a process for the preparation of an adhesive composition and then states that the process comprises the step of successive or simultaneous addition to said adhesive composition. Accordingly, the preamble of Claim 10 states that the process is for preparation of an adhesive composition and the body of the claim recites successive or simultaneous addition of components to said adhesive composition. Thus, while the preamble of the independent claims already breathe life and meaning into the body of the claims, the bodies of the claims refer back to elements recited in the preambles. Accordingly, Applicants submit that the preamble language of these claims cannot be ignored under applicable legal precedent for at least this additional reason.

For at least these reasons, Applicants submit that independent Claims 10 and 18 are patentable over Nabavi. The remaining claims (Claims 11-17 and 19-21) depend, directly or indirectly, from these independent claims, and are, therefore, also patentable over Nabavi for at least the reasons that Claims 10 and 18 are patentable.

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

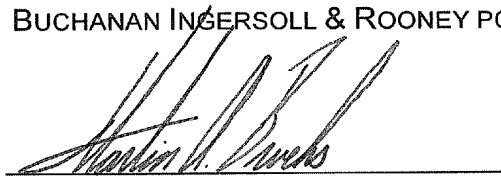
If there are any questions concerning this paper or the application in general,
Applicants invite the Examiner to telephone the undersigned at the Examiner's
earliest convenience.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: February 11, 2008

By:

A handwritten signature in black ink, appearing to read "Martin A. Bruehs", is written over a horizontal line.

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